Office of Counsel

Patents and Technology Transfer

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- Patent Process
- Technology Transfer
- Federal Trade Secrets Act

Patent Process

- Invention Disclosure
- Preparation and Filing of US and Foreign Patent Applications
- Issue of Patent
- Payment of Maintenance Fees

Technology Transfer

- Cooperative Research and Development Agreement (CRADA)
- Short Form CRADA - Material Transfer Agreement
- Patent Licensing Agreement (PLA)

Invention Disclosure

- Recorded in Laboratory Notebook
- Review by Chain of Command
- Forwarded to OTT/OOL
- Review by Invention Evaluation Committee

OOT/OOL Action

- Request Further Proof of Concept from Inventor (more data)
- Recommend Patenting (Military Need, Commercial Success)
- Leave Rights with Inventor

Types of US Patent Applications

- Utility - Grant from Date of Issue until 20 Years from Date of Earliest Filing
- Provisional - No Patent Grant
- Design - Grant from date of Issue until 14 Years Thereafter
- Plant - Same Grant as Utility Patent

- US Patent Applications
  - Provisional - Lapses After One Year
  - Regular U.S. Filing -- Pending for 2-5 Years at USPTO
  - One year Grace Period from First Public Disclosure
- Foreign Patent Applications
  - PCT - Patent Cooperative Treaty
  - Absolute Novelty - Any Public Disclosure Prior to Filing
    Destroys Ability to Obtain Patent

Provisional
Pitfall for the Unwary

- Fewer Formal Requirements than Regular US Filing
- Only as good as the Material Presented
- Good way to Preserve Absolute Novelty - Impending Publications, Conference Presentation
  Starts the One-year Clock Ticking for Priority Date

One-Year Clock for Priority Date

- Paris Convention of 1883
- 35 USC 119 - Foreign and US Provisional
- 35 USC 120 - US Regular Filing

Is the Invention Patentable?

- 35 USC 101 - Not Eligible Subject Matter, Lacks Utility, Double Patenting
- 35 USC 102 - Novelty, Promptness
- 35 USC 103 - Nonobviousness
- 35 USC 112 - Formal Requirements

35 USC 101 Eligible Subject Matter

- Any New and Useful
  - Process
  - Machine
  - Article of Manufacture
  - Composition of Matter
  - Improvement Thereof

35 USC 101 (continued)

Utility

- No Perpetual Motion Machines
- No Cold Fusion

Double Patenting

- Only One Patent Per Invention
- Identical Claim Language
- Similar Claim Language - Obviousness-type
- Terminal Disclaimer Practice

35 USC 102

- Novelty - Invention Exactly Disclosed by Another? - Firstness
- Promptness - Did you File Quickly Enough?

35 USC 103
Nonobviousness

- State of the Prior Art
- Differences Between Invention and Prior Art
- One of Ordinary Skill in the Art
- Suggestion or Teaching in Prior Art to Combine References

35 USC 112

- Enabling Disclosure
- Adequate Written Description
- Best Mode
- Clarity in Claim language

Regular US Filing

- Filing Receipt
- Notice to File Missing Parts

First Office Action

- Restriction Requirement
- More than One Invention
- Patentably Distinct Inventions

First Office Action on the Merits

- 35 USC 101 - Not Eligible Subject Matter, Lacks Utility, Double Patenting
- 35 USC 102 - Novelty, Promptness
- 35 USC 103 - Nonobviousness
- 35 USC 112 - Formal Requirements

Second Office Action on the Merits

Allowance - Pay Issue Fee

Final Rejection - File Appeal Brief /Abandonment

Patent Granted

Maintenance Fees

- 6 Months Prior to 4 Years
- 6 Months Prior to 8 Years
- 6 Months Prior to 12 Years

Technology Transfer
CRADAs- 15 USC 3710a

- Leverages the Resources of a Federal Laboratory
- Federal Labs May Work with: Persons, Companies, Nonprofit Organizations Including Universities
- Federal Labs May NOT Work with Foreign Governments
- CRADAs with Foreign Entities - Must Consult with US Trade Representatives
- Mission-Related
- Federal labs Shall Not Directly Transfer Money to CRADA Collaborating Party

CRADA Provisions

Intellectual Property Rights

Nondisclosure Terms

Publication Provisions

Duration - Typically 3 to 5 Years

Exemption from FOIA Requests

Domestic Technology Transfer

PLAs 35 USC 207, 209

- Nonexclusive Licensing
- Partially Exclusive Licensing
  - *Geography, Field of Use*
- Exclusive Licensing

Domestic Technology Transfer

PLAs 35 USC 3710a, 3710c

- 15 USC 3710a - Lab Directors May Sign PLAs
- 15 USC 3710c - Royalties
- First $2000 to Inventors + 20% of Remainder Per Year
- Statutory Purposes - Lab May Keep Monies Collected
- Exception to Miscellaneous Receipts Rule
- Money not Spent or Obligated after 2 Years Returned to Treasury

Odds and Ends -- 18 USC 1905

Federal Trade Secrets Act

- Prohibits Knowing Disclosures of Trade Secrets
- You Don’t Disclose Proprietary Data to Anyone!
- Shall be Fined Not More than $1000
- Shall be Imprisoned Not More than One Year
- Both Fine and Imprisonment
- Shall be Removed from Office or Employment

18 USC 1905
(Continued)

- How could a Gov't Employee get access?
  - Procurement Contracts
  - CRADAs
  - Cooperative Agreements
  - Technical Data Package